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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

COLEMAN, ERIC

ART UNIT PAPER NUMBER

2183

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/353,625

Applicant(s)

EKKER ET AL.

Examiner

Eric Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-8,10,19-22,25,28 are rejected under 35 U.S.C. 102(e) as being anticipated by Loeb (patent No. 6,014,641).
3. Loeb taught the invention as claimed including a data processing ("DP") system comprising: a continuously running event creation process determining whether a system initiated and created event is due to be created (e.g., see col. 9, lines 7-37); and a continuously running pricing process pricing (claims 1,2,19-22,25,28) the system-created events (e.g., see col. 9, lines 7-37) and non-system created events (e.g., see col. 4, line 15-col. col. 5, line 67) as they become available to the system. As to the computer readable storage medium (claim 28) the Loeb taught a computer system that stored a data base of subscription information and an agent that implements the

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process controlling the computer (e.g., see col. 3, lines 7-19, and fig.6). Inherently the process would have to have been stored in a computer readable storage.

4. As to claims 3,4,7,8 Loeb taught a providing a flexible changeable scheduling of system created events that can happen or less frequently or with the same frequency as the billing but can happen at the earliest available time (e.g., see col. 9, line 38-col. 11, line 30). As to claim 5,6, Loeb taught maintaining a database for created events in real-time (e.g., see col. 10, lines 67). Loeb taught (claim 10) recalculation of charges (e.g., see col. 9, lines 37-col. 10, line 62).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9,23,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb '641 as applied to claims 1-8,19-22, above, and further in view of Loeb '652.

6. Loeb '641 did not expressly detail (claims 23) determining whether a system initiated event was priceable and pricing the event responsive to the determining. Loeb '562 taught subscription events that were free (e.g., see col. 9, lines 18-44). For these free subscription events it would have been obvious to one of ordinary skill that when the Loeb '652 system determined whether the payment was due as taught by Loeb '641, the system would have contained subscriptions events that were priceable and those that were not. Therefore it would have been obvious to one of ordinary skill in the

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art that the system implemented using the Loeb '652 and Loeb '641 teaching would have initiated an event to determine whether the payment was due and whether the event was priceable (i.e., whether it was free or not) and then priced the subscription events that were priceable. Further as the limitation wherein all charge events for current billing period are priced at first opportunity after a prior billing period Loeb '641 taught the synchronizing of payments for multiple open-ended subscriptions (e.g., see col. 11, lines 4-14).

7. Loeb '641 did not specifically detail the display of the system created events (claim 9,24). Loeb '652, however taught a graphical user interface (GUI) for interfacing the user with the system in the system that transmitted records of system created events (e.g., see col. 3, line 40-col.5, lines 4-37). Therefore it would have been obvious to one of ordinary skill in the DP that the pricing for the events would have been displayed on the GUI in the Loeb '641 and Loeb '652 system.

8. It would have been obvious to one of ordinary skill in the DP art to combine the teachings of Loeb '641 and Loeb '652. Both references were directed toward the problems of providing a system to process magazine subscriptions including billing. The addition of the Loeb '652 teachings of providing for free promotional subscriptions would have allowed the Loeb '641 system would have added additional flexibility to the system and improved the systems usefulness in marketing magazine subscriptions.

9. Claims 11-18,26,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb '641(patent No. 6,014,641) in view of Loeb '652 (patent No. 6,421,652).

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10. Loeb taught the invention substantially as claimed including a data processing ("DP") system comprising: a continuously running event creation process determining whether a system initiated and created event is due to be created (e.g., see col. 9, lines 7-37); and (claims 12,13) a continuously running pricing process pricing the system-created events (e.g., see col. 9, lines 7-37) and non-system created events (e.g., see col. 4, line 15-col. col. 5, line 67) as they become available to the system.

11. Loeb '641 did not expressly detail (claims 11,14,15,16,27) determining whether a system initiated event was priceable and pricing the event responsive to the determining. Loeb '562 taught subscription events that were free (e.g., see col. 9, lines 18-44). For these free subscription events it would have been obvious to one of ordinary skill that when the Loeb '652 system determined whether the payment was due as taught by Loeb '641, the system would have contained subscriptions events that were priceable and those that were not. Therefore it would have been obvious to one of ordinary skill in the art that the system implemented using the Loeb '652 and Loeb '641 teaching would have initiated an event to determine whether the payment was due and whether the event was priceable (i.e., whether it was free or not) and then priced the subscription events that were priceable. Further as the limitation wherein all charge events for current billing period are priced at first opportunity after a prior billing period Loeb '641 taught the synchronizing of payments for multiple open-ended subscriptions (e.g., see col. 11, lines 4-14).

12. Loeb '641 did not specifically detail the display of the system created events (claim 18,26). Loeb '652, however taught a graphical user interface (GUI) for interfacing

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the user with the system in the system that transmitted records of system created events (e.g., see col. 3, line 40-col.5, lines 4-37). Therefore it would have been obvious to one of ordinary skill in the DP that the pricing for the events would have been displayed on the GUI in the Loeb '641 and Loeb '652 system.

13. It would have been obvious to one of ordinary skill in the DP art to combine the teachings of Loeb '641 and Loeb '652. Both references were directed toward the problems of providing a system to process magazine subscriptions including billing. The addition of the Loeb '652 teachings of providing for free promotional subscriptions would have allowed the Loeb '641 system would have added additional flexibility to the system and improved the systems usefulness in marketing magazine subscriptions.

14. As to the limitations of claim 17, the procedure of calculating of the minimum and maximum charge is within the level of skill of one of ordinary skill in the billing art. It is routinely performed to indicate the minimum charge for a bill if the bill is paid on time and a maximum charge if the bill is paid late.

15. The change in scope of the amended claims has necessitated a new search.

16. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Griebenow (5,850,520) disclosed a system for electronic publication distribution including return receipt (e.g., see abstract).

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Coleman whose telephone number is (703) 305-9674. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Chan can be reached on (703) 305-9712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

EC
October 1, 2002



ERIC COLEMAN
PRIMARY EXAMINER